

REMARKS

Claims 1-2 and 4-11 are pending in this application after this amendment. Claim 3 has been canceled without prejudice or disclaimer to the subject matter included therein. New claims 4-11 are presented for consideration by the Examiner. No new matter has been added by the addition of these new claims. Claim 1 is independent. Based on the amendments and remarks made herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

By this amendment, Applicant has amended claim 1 to more appropriately recite the present invention. This amendment is being made without conceding the propriety of the Examiner's rejection, but merely to timely advance prosecution of the present application.

In the outstanding Official Action, the Examiner rejected claims 1-2 under 35 U.S.C. §102(b) as being anticipated by JP 10-297039 (hereinafter "'039 reference"); and rejected claims 3-4 under 35 U.S.C. §103(a) as being unpatentable over the '039 reference in view of JP 4-58355 (hereinafter "'355 reference"). Applicant respectfully traverses these rejections.

In support of the Examiner's rejection of claim 1, the Examiner asserts that the '039 reference discloses all of the claim elements, including an image forming apparatus wherein the upper sheet ejecting roller is divided in a direction perpendicular to a sheet transport direction into a plurality of portions and the portions are in direct contact with the lower sheet ejecting roller at respective points in the sheet transport direction. In support of this assertion, the Examiner cites to rollers 36 and 37 as depicted in figures 3 and 5-6.

The disclosure of the '039 reference is directed to a recording device that includes a first spur group 36 and a second spur group 37. The spur groups counter the delivery roller and sandwiches the recorded material by arranging the two or more spurs in different parallel shaft positions [paragraph 0018]. Further based on this composition, it is possible to protect the relief on the back end, wherein a recording head does not come in contact with a recording material [paragraph 0020].

The Examiner rejected claim 3 asserting that the '355 reference taught the upper sheet ejecting roller including a sheet pinch roller, a first lift-preventing roller, and a second lift-preventing roller, as claimed. The Examiner cites to Fig. 5, rollers 18a-18d to support the rejection. However, as can be seen from the '355 disclosure, these rollers appear to ensure that the sheet is properly pulled up from the image forming portion to the outside of the apparatus.

In contrast, claim 1, as amended, recites, *inter alia*, an image forming apparatus wherein the upper sheet ejecting roller includes a sheet pinch roller, a first lift-preventing roller, and a second lift-preventing roller, wherein the sheet pinch roller, the first lift-preventing roller, and the second lift-preventing roller are in direct contact with the lower sheet ejecting roller at respective points in the sheet transport direction, and wherein the sheet pinch roller, the first lift-preventing roller, and the second lift-preventing roller are not in the same straight line parallel to the sheet transport direction.

Neither the '355 reference nor the '039 reference teach, either alone or in combination, lift preventing rollers as recited in the claim. Rollers 18a-18d appear to ensure that the sheet is properly pulled up from the image forming portion to the outside of the apparatus. They do not ensure that a tail end of the sheet is prevented from being lifted up in an image forming position.

In addition, rollers 18a-18d are not in direct contact with the lower sheet ejecting roller at respective points in the sheet transport direction, and further, the sheet pinch roller, the first lift-preventing roller, and the second lift-preventing roller are not in the same straight line parallel to the sheet transport direction, all as required by amended claim 1.

For at least these reasons, Applicant respectfully submits that claim 1, as amended, is not obvious over the references as cited.

Further, at least based on the positioning of rollers 18a-18d, modifying the '039 reference to include the 18a-18d rollers would change the principle of operation since the sheet would be transported to a position that is not in or near the sheet receiving tray. Further, this modification would render the device inoperable since the sheets would not be collected in the tray, but would

fall out of the device. It is well established that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In addition, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As the proposed modification would render the device inoperable for its intended purpose, and as the proposed modification would change the principle of operation of the resultant device, Applicant respectfully submits that the proposed modification is improper.

Finally, the proposed modification would require substantial reconstruction. It is well established that where the suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate, the combination would be improper. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

For all of the reasons set forth above, Applicant respectfully submits that one skilled in the art would not be motivated to make the combination as suggested by the Examiner, and thus, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2 and 4-11 are allowable for the reasons set forth above with regard to claim 1 at least based on their dependency on claim 1.

Conclusion

In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisin (Reg. No.

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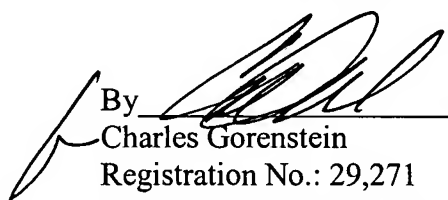
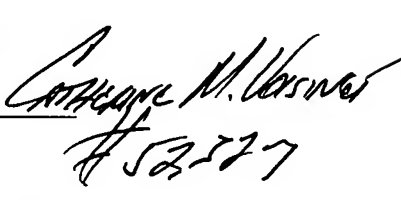
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52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: October 15, 2007

Respectfully submitted,

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